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ANDREWS KURTH LLP
1350 I STREET, N.W.
SUITE 1100
WASHINGTON DC 20005

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|-----------------------------|---|----------|
| In re Application of | : | |
| Egger | : | DECISION |
| Application No.: 09/854,577 | : | |
| Filing Date: 15 May, 2001 | : | |
| Attorney Docket No. 4256B | : | |

This is a decision on the petition filed on 11 May, 2007, to revive the instant application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing the instant matter, however, the application was presented to the Office of Petitions only at this writing.

The Revocation/Power of Attorney filed of record is acknowledged and entered.

For the reasons set forth below the petition as under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 30 March, 2004, with reply due absent extension of time on or before 30 June, 2004;
- the application went abandoned by operation of law after midnight 30 June, 2004;
- the Office action was returned as undelivered on 9 July, 2004;

- Counsel filed a Notice of Change of Address on 7 October, 2004;
- the Office mailed the Notice of Abandonment on 28 March, 2005;
- with the original petition (with fee), then-Petitioner (Stephen R. Whitt (Reg. No, 34,735))—(apparently not Counsel of Record): submitted no proper Revocation/Power of Attorney) but nonetheless attempted to change the mailing address without the appropriately demonstrated authority; filed a statement that the application was being revived for co-pendency with a concurrently filed divisional (as the reply) and then being expressly abandoned, but provides no copy or other evidence thereof (while Office records may suggest at this writing a parent/child relationship with another application, in the absence of the pendency of the instant matter, as a matter of law no relationship exists); argued without expressly demonstrating deception by Counsel and cited *Lonardo* 17 USPQ2d 1455 (Comm'r. Pat. 1990) in connection therewith; submitted a statement by a co-inventor, who alleges but does not evidence the holding of the entire interest (and no assignments are of record), made allegations as to Counsel (but evidences no effort to address the matter with the Office of Enrollment and Discipline (OED)), and alleged unintentional delay, but, as indicated above, such allegations remain unsupported in the record—further, the extended delays with Petitioner's suggestion of inappropriate action by Counsel in the absence of such representation to OED suggested at least some inconsistencies in the representations to the Office; moreover, it does not appear that Petitioner filed with the original petition a reply to the outstanding Office action as required under the regulation—and so the petition was dismissed on 19 June, 2006;
- with the petition filed on 10 July, 2006, Petitioner submitted, as indicated above, a Revocation/Power of Attorney directed to another application—Petitioner is aware as a registered practitioner that each and every application is a separate application (37 C.F.R. §1.4(b)), and the paper in question appears to be misdirected by Petitioner; and no reply was been filed of record to the outstanding Office action of 30 March, 2004, as required under the regulation—and so the petition was dismissed on 1 March, 2007;
- on 11 May, 2007, Petitioner filed the instant petition with fee, reply in the form of an amendment, and a statement/showing of unintentional delay by a co-inventor and holder of the entire interest of the application (on showing of recorded assignment(s)) in an effort to overcome the former deficiencies.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always should note that those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See *Changes to Patent Practice and Procedure*, 62 *Fed. Reg.* at 53160 and 53178, 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁵ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

Allegations as to
Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

It appears as that Petitioner has satisfied the requirements under the regulation.

CONCLUSION

The petition as under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU 2174 for further processing in due course.

⁶ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁸) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁸ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.